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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,810	08/13/2001	James J. Lalonde	1690A1	8220

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PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
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EXAMINER
MARX, IRENE

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,810

Applicant(s)

LALONDE, JAMES J.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13-15,16,18-27,29,31, 33--44 is/are pending in the application.
- 4a) Of the above claim(s) 16,18-27,29,42 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-15,31, 33-41 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/4/03 has been entered.

Claims 1-3, 5-11, 13-15, ³¹/_h 33-41 and 44 are being considered on the merits. Claims 16, 18-27, 29 and 42-43 are withdrawn from consideration as directed to a non-elected invention.

Claims 1-3, 5-11, 13-15, ³¹/_h 33-41 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 31, 41 and 44 are vague and indefinite in the recitation in the preamble of “producing 2-oxoglutaramate” and in the body of the claim of “to produce a product comprising 2-oxoglutaramate”. Amendment of the body of the claim to recite “to produce 2-oxoglutaramate” would be remedial. The amount of 2-oxoglutaramate contained in “a product comprising 2-oxoglutaramate” is uncertain. Cf. claim 14, which appears correct in this respect.

Claims 9, 10, 14 and 35 are vague and indefinite in the recitation of “incubation solution” regarding a “slurry” or “solid glutamine”, since this does not appear to constitute a proper “solution”.

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues that the 250 mM and 250 g/l glutamine pertain to a glutamine reactant in solution, respectively a “glutamine reactant ... present in the incubation solution initially as a solid”. However, the claims as written pertain to an “incubation solution” which comprises solid glutamine according to this argument. This appears incorrect, since either glutamine is in solution or it is not. The claims do not address “initially”.

Therefore the rejection is deemed proper and it is adhered to.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-11, 13 and 31 are/remain rejected under 35 U.S.C. 103(a) as being unpatentable over Meister taken with Szwajcer *et al.* for the reasons as stated in the last Office action and the further reasons below.

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicants arguments regarding the unpredictability of the effects of the oxidative deamination of glutamine using the enzymes of specific bacterial cells as disclosed in Szwajcer *et al.* are persuasive. However, these arguments are not directed to the effects of using unknown “active” enzymes obtained from *Providencia* or *Proteus* in the process. There is nothing on the record to substantiate that the effects of “active” biocatalysts obtained from *Proteus* or *Providencia* differ significantly in their effects from the snake venom biocatalysts used in the Meister reference, for example, which has been shown to have the required activity. Thus, the use of “active biocatalysts” is taught in the art.

Applicant asserts that Szwajcer *et al.* does not provide one skilled in the art sufficient information from which a predictable pattern of L-amino acid oxidase activity to *Providencia sp.* 1298 can be derived. Yet the present written disclosure does not appear to provide a protocol to obtain “active biocatalysts” from the strains, but rather uses a wet cell paste.

As noted the production of “active biocatalysts” for the oxidative deamination of glutamine is taught by Meister, albeit from a difference source. However, the source of a biocatalyst does not necessarily confer patentability as alleged, since the activity is the same. Moreover, absolute predictability is not required to set forth a *prima facie* case of obviousness.

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The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. In re Dill, 202 USPQ 805 (CCPA, 1979), In re Lindner 173 USPQ 356 (CCPA 1972), In re Hyson, 172 USPQ 399 (CCPA 1972), In re Boesch, 205 USPQ 215, (CCPA 1980), In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983), In re Clemens, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

Claims 14-15, 33-40, 41 and 44 would be allowable upon resolution of all 35 U.S.C § 112 issues and if rewritten to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 703-308-2922. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0926.



Irene Marx
Primary Examiner
Art Unit 1651